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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/538,634

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Yasuhito Yuasa

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EXAMINER

RODEE, CHRISTOPHER D

ART UNIT

PAPER NUMBER

1795

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/538,634	Applicant(s) YUASA, YASUHIITO	
	Examiner Christopher RoDee	Art Unit 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-12,14-24 and 28-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-12, 14-24, and 28-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3-12, 14-24, and 28-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The instant claims have been amended to specify that the inorganic micropowder surface is coated with polysiloxane and the at least one fatty acid or derivative. Basis for the amendment is stated as being derived from specification page 16.

A review of the specification shows specific processes for forming the claimed product. Specifically, the relevant passage states,

“The surface treatment is performed by dissolving the above polysiloxane and fatty acid in a hydrocarbon (sic) organic solvent such as toluene, xylene, hexane, or isopar (sic), wet mixing this solution along with silica, titanium oxide, alumina, or another such micropowder in a disperser, causing the polysiloxane or fatty acid to adhere to the surface of the micropowder by using a treatment agent, and thereby effecting a surface treatment, after which this product is dried and the solvent is removed.” The specification in this passage states that the polysiloxane or the fatty acid are adhered to the surface of the micropowder by the use of a treatment agent. This passage makes clear that two key features of the relationship of the polysiloxane and the

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fatty acid with the micropowder are not present in the claims. First, the polysiloxane and the fatty acid compound are “adhered” to the surface of the micropowder. The current claims present any type of coating including a loose particle coating. This would not be an adhered coating. Second, the specification requires a treatment agent to adhere the components to the micropowder. No treatment agent is present in the claims. Because all claims have the coating limitation directly or by their dependency, this rejection is pertinent to all claims. The Examiner notes that the coupling agent in claims 30 and 33 appears to be treatment agent according to the specification, but this component is not required in these claims and not used in the same manner as specified in the specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshino *et al.* in US Patent Application Publication 2004/0058258.

Yoshino discloses a toner comprising a binder resin, a colorant, and a wax releasing agent, a mixture of external additives having a first size of from 5 to 30 nm and a second size of from 30 to 70 nm, and another external additive that is a surface coated silica (Abstract; ¶¶ [0053], [0095] - [0097]). The external additive is an inorganic oxide coated with a polysiloxane and a fatty acid metal salt (¶¶ [0072] – [0075], [0086], & [0087]) and is a silica, titanium oxide, alumina, or zinc oxide with a volume-average particle size of from 80 to 300 nm (¶¶ [0059],

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[0062], [0065]). Exemplified fatty acid metal salts include zinc stearate and calcium stearate (see ¶ [0087] & Inorganic Oxide Powders (A) – (C)). The polysiloxane is added in an amount of from 0.15 to 45 parts by weight per 100 parts by weight of the inorganic powder and the fatty acid metal salt is in similar amounts, preferably 3 to 30 parts per 100 parts by weight of the inorganic powder (¶¶ [0079] & [0082]).

The toner is mixed with a coated carrier to form a two-component developer (¶¶ [0099] – [0111]). Useful resins include fluorine resins and silicone resins (¶ [0102]).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a combination of a polysiloxane and a fatty acid metal salt, such as zinc stearate or calcium stearate, as coating materials for the external additive oxide because both compounds are disclosed as useful and the artisan would have found it obvious to select from those materials disclosed as useful for their specified purpose.

Applicant's claim for section 119 priority cannot be given for these claims because the claims contain new matter. In order for a section 119 priority claim to be granted, the specification and the foreign application must both describe the invention within the meaning of section 112, first paragraph. Neither describes the claims as now presented.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher RoDee whose telephone number is 571-272-1388. The examiner can normally be reached on Monday to Thursday from 5:30 to 4:00 Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher RoDee/
Primary Examiner
Art Unit 1795

2 March 2009